

Applicant : Dudley Finch et al
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REMARKS

Reconsideration of the above-identified patent application is respectfully requested. As set forth in more detail below, Applicants respectfully traverse the restriction requirement. If the restriction requirement between Group I and Group II is maintained, Applicants provisionally elect to proceed with the prosecution of the Group I claims, namely claims 1-8, 14-22, 24, 25, and 27-29.

It is asserted that the pending application is directed to the following patentably distinct inventions:

Group I: Claims 1-8, 14-22, 24, 25, and 27-29, drawn to an electrode and methods of making and using the same.

Group II: Claims 9-13, 23, and 26, drawn to a coating for an electrode.

Applicants respectfully traverse the restriction requirement.

It is asserted that the inventions of Group I and Group II are distinct because the two groups relate to a combination and a sub-combination, respectively, and the combination “doesn’t require the particulars of the subcombination for patentability.” It is respectfully submitted that this position does not support the asserted restriction requirement because the subject matter of the claims in Group II is a more specific recitation of the subject matter of the claims of Group I. The subject matter of the claims of Group II relate to a coating that enables the electrode of Group I to function in the recited manner.

Further, Applicants note that restriction is proper only when prosecution of the allegedly distinct inventions would place “a serious burden on the examiner.” (MPEP § 803.01).

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It is respectfully submitted that prosecution of the Group I and Group II claims simultaneously will not present a serious burden. Here, the allegedly distinct inventions are directed to a slowly implantable electrode and a coating that enables the electrode to be slowly implantable. There is no indication that the allegedly distinct inventions have been classified in different classifications, and Applicants believe that prosecution of either the Group I or Group II claims would likely be accompanied by the same search and analysis of the same prior art references. Accordingly, separation of the allegedly distinct inventions would not relieve the Examiner of any burden--let alone a *serious* burden.

As noted above, if the restriction requirement between Group I and Group is maintained, Applicants provisionally elect to proceed with the prosecution of the Group I claims, namely claims 1-8, 14-22, 24, 25, and 27-29.

In view of this Response, Applicants respectfully request prosecution of the application on the merits.

Respectfully submitted,

DUDLEY FINCH ET AL

By: Warner Norcross & Judd LLP

/Amy E. Rinaldo/

Amy E. Rinaldo
Registration No. 45,791
900 Fifth Third Center
111 Lyon Street, N. W.
Grand Rapids, MI 49503-2487
(248) 784-5107